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| EXAMINER |
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3629

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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AUG 11 2005

**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/056,832  
Filing Date: January 24, 2002  
Appellant(s): WHITCOMB, CURTIS A.

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Robert D. Null  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 7/11/05.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of the Claimed Invention***

The summary of the claimed invention contained in the brief is correct.

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**(6) *Grounds of rejection to be Reviewed on Appeal***

The appellant's statement of the grounds of rejection on appeal is correct. As applicant stated on page 8 of the Appeal Brief, due to an oversight by the examiner, claim 49 was supposed to be included in the 35 USC 101 rejection on appeal.

Applicant noted that this appeared to be an oversight and the examiner agrees. This should not affect the ability of the Board of Patent Appeals and Interferences to make a decision on the merits of the issues.

With respect to the "Hot Wheels" reference, the examiner has considered applicant's arguments and found them persuasive; therefore, the rejection under 35 USC 102(b) in view of the "Hot Wheels" references is not maintained and is not part of this appeal.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

5960411

Hartman et al.

9-1999

"Sweating the details", Fernwood of Maine's colorful handcrafted replicas of buildings and scenes find a ready, robust market., Portland Press Herald; Portland, ME, 6/11/2000, by Tux Turkel, 4 pages

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1,3-20,22-32,49-52, are rejected under 35 U.S.C. 101. This rejection is set forth in a prior Office Action, mailed on 4/27/05.

Claim 51 is rejected under 35 U.S.C. 112,1<sup>st</sup> paragraph. This rejection is set forth in a prior Office Action, mailed on 4/27/05.

Claims 1,4-7,9,10,12,14,15 are rejected under 35 U.S.C. 102(a). This rejection is set forth in a prior Office Action, mailed on 4/27/05.

Claims 33-39,45 are rejected under 35 U.S.C. 102(b). This rejection is set forth in a prior Office Action, mailed on 4/27/05.

Claims 3,8,11,13,16-20,22-32,49-52 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on 4/27/05.

**(11) Response to Argument**

**With respect to the traversal of the 101 rejection** that finds the claims to be non-statutory, the arguments are non-persuasive. The sole issue is not just whether or not the claimed method is useful and produces a tangible concrete result as argued. The issue is whether or not the claims recite an invention that is considered to be within the technological arts (as well as being non-trivial use of technology), where the invention is useful and produces a tangible concrete result. Applicant has cited *Ex parte Bowman*, where it was concluded that the claimed idea was an abstract idea and not within the technological arts because applicant did not tie the disclosed and claimed

invention to any technological art. What this means is that applicant must claim the technology in addition to having it disclosed in the specification. It is not enough to argue that the method could be performed by technology where the method does not recite any technology. Limitations will not be read into the claims for purposes of the statutory 101 analysis. Also, a look at the claims reveals that all of the recited steps are generic in nature and cover every possible way of performing the claimed steps. This is direct evidence that the claimed invention is directed to nothing more than an abstract idea, which is not considered statutory.

With respect to claims 8,13,23, and the argument concerning the finding by the examiner that the act of sending the information over a network between a registrar computing device and a merchant computing device does not render the method claim as statutory or that the entering of data into a database of a computing device does not render the claims statutory, the examiner notes that a process is considered statutory if the recited acts involve manipulation of tangible objects and result in the object having a different physical attribute or structure (*Diamond v. Diehr*, 450 US at 187, 209 USPQ at 8). In the "Summary of the Claimed Invention" section of the Appeal Brief, applicant stated on page 3 that "the replica manufacturer 18 either selects an appropriate replica from stock or custom manufactures the replica based on the information". The claim scope for claims 8,13,23, does not require that the information that is being transmitted is used to make a replica that is customized in any manner. In the example where a replica is taken from stock, nothing is being manipulated or changed from one state to another so the mere act of transmitting the information is not considered sufficient to

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render the claim statutory and it taken as an insignificant type of post solution activity.

In other words, the information being transmitted is not being used to make a custom replica because the replica can be retrieved from stock and would not be custom made.

The act of just saving information on a database also involves no manipulation of any kind. From MPEP 2106, the following is also disclosed:

- step of "transmitting electrical signals representing" the result of calculations (*In re De Castelet*, 562 F.2d 1236, 1244, 195 USPQ 439, 446 (CCPA 1977) ("That the computer is instructed to transmit electrical signals, representing the results of its calculations, does not constitute the type of post solution activity' found in *Flook*, [437 U.S. 584, 198 USPQ 193 (1978)], and does not transform the claim into one for a process merely using an algorithm. The final transmitting step constitutes nothing more than reading out the result of the calculations.")); and

-step of displaying a calculation as a gray code scale (*In re Abele*, 684 F.2d 902, 908, 214 USPQ 682, 687 (CCPA 1982)).

Limitations directed to insignificant activities such as the merely the saving of information in a database are not considered sufficient to render the claims statutory.

With respect to the comments about an After Final interview that was conducted with the examiner, the examiner notes that an interview was conducted after first action (and is of record) but the discussion that occurred after final rejection did not constitute an interview on the merits. If it did, then applicant's counsel and the examiner were obligated to submit a written summary of the interview. See MPEP 713.04, "It is the responsibility of the applicant or the attorney or agent to make the substance of an

*interview of record in the application file, except where the interview was initiated by the examiner and the examiner indicated on the "Examiner Initiated Interview Summary" form (PTOL-413B) that the examiner will provide a written summary. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability."* Applicant's counsel called and asked the examiner if anything had possibly changed with respect to the position of the examiner on the 101 issues. The examiner stated that nothing has changed. Applicant's counsel inquired as to whether or not the examiner's supervisor would be willing to discuss the 101 rejection. An interview was not granted. In the opinion of the examiner this did not constitute an interview on the merits as summarized by applicant's counsel, and if it did, applicant has not provided a written summary of the interview for the record. If the examiner thought it was in fact an interview on the merits an interview summary form would have been completed and mailed to applicant as was done for the interview of 1/31/05 (prior to Final rejection). The examiner does not agree with the comments made by applicant's counsel and finds them of little value in the statutory 101 analysis.

Concerning claim 52, applicant has relied upon the argument for claims 8,13,23, and the position of the examiner is the same as that set forth above.

**Concerning the new matter rejection of claim 51**, the language from the specification cited by applicant as support for this limitation has a scope that can allow for the offer to be made at a later time (after the purchase has been made) and because



of this the making of the offer "at the same time" as the sale of the product is new matter that is not inherent to the originally disclosed invention. For the limitation to be considered inherent applicant must show that having the offer made at the time of the sale is necessarily present in the disclosure. That is not the present case because as applicant has admitted, the language from the specification includes the situation where the offer is made at a later time, which means that having the offer made at the same time of sale of the product is *not necessarily present*. Applicant is taking a broad generic statement and reciting one species that the generic statement can possibly include which is improper and is new matter. The citation describing figure 4 at best indicates that the offering is made after the product is purchased and does not support the making of the offer at the time of purchase. Step 410 is the purchasing of the product. Step 420 is offering the purchaser an opportunity to buy a replica that portrays the purchased (past tense) product 4. If you are offering a replica for purchase at the same time as purchasing the product, how can the product be referred to as being "purchased", which is past tense? The arguments are found as non-persuasive.

*The examiner takes notice that applicant previously had based the patentability of claims 4-6,9,10,12,14-15,20,22,31,32 on the argument for claim 1, and no further arguments for these claims were presented. In the final rejection the examiner stated that failure to present arguments for these claims is noted and in view of 37 CFR 1.111, the rejections are deemed proper because the argument for claim 1 was found as non-persuasive. Now for the first time, arguments are presented for claims 4,6,12,14,15. The examiner does not feel this is a timely presentation of the supposed errors in the*

*office action as is required by 37 CFR 1.111. The arguments will be addressed however.*

**With respect to the claims 1,4, and the 102(a) rejection in view of the Fernwood article “Sweating the details” applicant has argued that:**

*“Nothing in the Fernwood article teaches, expressly or inherently, that the bank offered the home buyer an opportunity to purchase a replica of the home. If anything, the Fernwood article seems to indicate that the bank simply asked Fernwood to paint replicas on its own accord, and provided those replicas as surprise gifts to the home owners.”*

The Bangor bank does offer a replica to the purchaser as claimed because the claimed term “purchase” is defined in the instant specification on page 2 as generally meaning “an exchange of value” and includes the act of bestowing a product. The home purchaser being given the replica of their home satisfies the claim language of “purchase” because the bank is bestowing the replica to the purchaser. Clearly when someone gives another person a gift, the gift can be taken or can be refused. Providing replicas as gifts satisfies the claim language based on applicant’s definition found in the specification.

For claims 5,9,10, applicant is relying on claim 1 for patentability and no new argument has been presented.

For claim 6, applicant has argued that information relating to an owner of a home cannot be considered as the style of home that the owner owns. The limitation of “information related to an owner of a product” is very broad language and the examiner

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sees no reason why the style of home cannot be considered as information that is related to an owner of a product. If the owner owns a particular style of home, the information about the home style is related to the owner because the owner owns a house of that style. With respect to the argument that the examiner cannot consider the product information and owner information as being the same thing, the examiner does not see where this comes from in the rejection of record. Information relating to a visible feature of the home can be also related to the owner, such as a name on a door. The examiner does not know what to make of this argument because the examiner never stated that the product information and owner information are the same.

For claim 7, when a sales representative (the registrar) takes an order, such as from the bank, they are inherently associating the owner with the product based on the order itself. It is not reasonable to take a position that the sales representative of Fernwood will not be associating (very broad term) the owner and the replica to each other.

For claim 12, the Fernwood article discloses that contract artists have been hired as well as a sales representative. For the contract artists to be able to perform their job, an order must be given to the artists so they know what to make or what to get from stock. It is not reasonable to assume that no order information is transferred between the sales representative and the contract artists. The examiner feels that it is very reasonable and proper to conclude that the artists must receive some information (a replica order) so that they can perform the duty they have been hired for.

For claims 14 and 15, contrary to applicant's statement, these claims depend to claim 12, which is under rejection. They do not depend from claim 13 as stated. This is the only argument presented for these claims and is found non-persuasive.

**Concerning the 102(b) rejection in view of the Hartman patent and the 102(b) rejection in view of the Internet and connected computers** the arguments are the same for both rejections so the examiner has addressed them together. In response to applicant's argument that the examiner has ignored the intended use method steps that are recited in the article claims, the examiner takes the position that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, which in this case the prior art is fully capable of transferring the claimed type of data as claimed, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The prior art is fully capable of doing what is claimed and the claimed intended use results in no structural difference from the prior art.

With respect to claim 38, applicant has argued that the examiner is incorrect in stating that the data claimed as being stored in the database is non-functional descriptive material. Based on applicant's argument, one could obtain a patent to a

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computer with a database that stores your name, height, and weight, because no teaching could be found that has a computer with your name, height, and weight stored in the database. This is essentially an argument that the kind of data stored on the database makes the article (the computer itself) patentable. The examiner disagrees. A personal computer, and the computers are Hartman, are fully capable of storing any kind of data the user desires and reciting the kind of data that is being stored does not add any further structure to the claimed invention. If the data that is stored in a database makes a computer patentable, then every person in the world can feasibly obtain a patent by simply claiming his or her name as being stored in a database. The examiner believes the claims to be properly rejected.

For claim 45, applicant is again arguing the intended use of the device for patentability, where the prior art devices are fully capable of updating data as set forth in the rejection of record. With respect to the kind of data that is being updated, the examiner takes the position similar to that of claim 38, in that reciting the kind of data that the computer can update does not define any further structure to the article claimed. The prior art is fully capable of doing what is claimed.

**With respect to the 103 rejection in view of Fernwood**, the examiner notes that applicant has based the patentability of claims 3,8,19,23,24,27,28,31,32 on the argument presented for claim 1. The argument for claim 1 is found non-persuasive for the reasons set forth previously, so claims 3,8,19,23,24,27,28,31,32 are considered to be properly rejected.

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Concerning claim 52, it appears that applicant feels that the use of a computing device is not in the prior art; however, applicant has stated "Applicant need not contest those conclusion, however, because..", so the examiner cannot rebut an argument not presented for review. The only argument presented for claim 52 is that the prior art does not disclose a certificate of ownership as claimed. Applicant stated that a receipt is not and cannot be considered as a certificate of ownership as the examiner has done. The examiner disagrees because a receipt is a proof of purchase and does indicate ownership. A person holding the receipt to an article has proof of its sale and is an indication of ownership. Because receipts are given to the purchaser, a person with no receipt would not be considered as the owner.

For claim 13, applicant has stated that Fernwood teaches away from what is claimed but has provided no reasoning as to why this conclusion is being made. This argument is non-persuasive for that reason. In small business operations it is very common to use computers and Fernwood discloses that an Internet web page is forthcoming. This requires a computer. Applicant has argued that even if the use of more than one computer is in Fernwood, it is not disclosed that orders are transferred from one computing device to another in the Fernwood business. The examiner has addressed this by the fact that the manufacturer (contract artist or other) must be told what to make. Transfer of data is necessary so that the replica maker knows what to make or pull from stock. In view of this fact the examiner takes the position that using computers to accomplish the data transfer is obvious to one of ordinary skill in the art. This is just using the computers to transfer the data as opposed to possibly a verbal

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transfer of data, or as opposed to a paper type of work order form being given to the manufacturer.

For claim 11, the claim scope allows for the product ID number and the replica ID number to be the same. In view of this fact, and in view of the fact that order numbers or invoice numbers are very well known, it would have been obvious to use a number to represent the transaction for purposes of recordkeeping and accounting.

For claims 16,29,49, see the comments for claim 52. Additionally, a holder of a receipt for a product is presumed to be the owner of the product. A receipt can be considered as a certificate of ownership contrary to what has been argued.

For claims 17,18, the examiner has made an obviousness statement that concludes that because in small businesses, it is very common and well known for employees to do more than one job, having any employee of Fernwood create the receipt for the replica would have been obvious to one of ordinary skill in the art. Perhaps the examiner could have worded his position in a different manner, the point the examiner is attempting to make is that somebody has to make the receipt so reciting that one person versus another makes the receipt is obvious to one of ordinary skill in the art because in small businesses, it is very common and well known for employees to do more than one job.

For claim 20, applicant has argued that the receipt that the examiner considers as being obvious does not associate the product and the replica with the owner. It does not appear that applicant is traversing the obviousness of having a receipt but is traversing the limitation of what is printed on the receipt. Claiming that the receipt

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contains product information and owner information is considered to be a recitation directed to printed matter that is non-functional descriptive material. Additionally, it is considered inherent that the receipt will contain information that can be considered to satisfy "product information" and "owner information". Applicant is arguing that the method is patentable based on what the receipt contains and the examiner respectfully disagrees.

For claim 22, the obviousness statement from the examiner dealing with the updating of records for a business that makes products, comes from what one of ordinary skill in the art would clearly see as obvious. Keeping records of what a company does is standard and routine business practice. The examiner has made an obviousness statement specifying how Fernwood is being modified contrary to applicant's comments. Also, the Fernwood article itself does not have to teach the modification because the keeping and updating of records is something that one of ordinary skill in the art would find obvious and if the article taught what is claimed then there would be no need for an obviousness statement as the reference would be disclosing what is claimed. The argument is non-persuasive.

For claim 25, all that is claimed is "obtaining the replica from stock" and the examiner sees nothing wrong with the interpretation of this being the act of taking a finished replica from an area where they are kept. Clearly a replica that is being made or has been made can be considered as "stock". It is also clear that they must be painted and kept somewhere to dry or to await delivery. For this claim applicant is



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arguing that the mere act of taking a replica from stock (taking something from a shelf) is a patentable invention and the examiner disagrees.

For claim 30, the examiner has pointed out and does so again, that the claim specifies "from the registrar to a merchant of the product". This is not a recitation to the same merchant as recited previously and this is why the examiner has stated that the newly recited merchant reads on the postal service mailing the replica. If the claim was to read "from the registrar to the merchant of the product" then this would simply be the act of the replica manufacturer given the bank the replica to give to the owner. The argument is non-persuasive.

For claim 51, the examiner has stated the reasoning as to why the timing of the offer is considered obvious and applicant has argued that the analysis of whether or not the timing of the offer affects the overall method has no place in an obviousness analysis. The examiner disagrees, especially when the limitation being argued is new matter to the specification and is not disclosed as providing any unexpected result or solving any particular problem. The examiner has clearly stated his position and simply disagrees that the timing of the offer renders the method patentable over the prior art. The argument is non-persuasive.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



DENNIS RUHL  
PRIMARY EXAMINER

August 4, 2005

Conferees

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